

“Office Action”) and the subsequent Advisory Action are incorrect in several material respects. First, contrary to the assertions of the Advisory Action, the Office Action continued to assert Official Notice despite repeated previous requests that the Examiner either rely exclusively on actual prior art references, or that the Examiner provide a formal affidavit. Second, the Examiner’s analysis and characterization of Applicants’ claims is overly generalized and summarily dismissive, precluding the required analysis with respect to the specific claim elements. Third, the scope of Official Notice asserted by the Examiner far exceeds the scope of the Ryder disclosure relied on in the Office Action. Fourth, the aggregation of all references cited by the Examiner fails to disclose all of the elements claimed by the Applicants, precluding the rejection of Applicants’ claims. Fifth, there is no suggestion in the art to combine the cited references as argued by the Examiner. In fact, the cited references teach away from each other.

Applicants’ claims are in condition for allowance. The Applicants file this Advisory Action Response with a Request for Continued Examination (“RCE”) and request a personal face-to-face interview with the Examiner. At that interview, the Applicants expect to be represented by their attorney and a client representative.

I. EXAMINER CONTINUES TO RELY OF OFFICIAL NOTICE

In the Office Action, the Examiner continued to assert Official Notice “regarding warranty and invoice handling.” [Office Action pages 3, 5, and 7]. The Examiner persisted in asserting Official Notice despite repeated requests by the Applicants that the Examiner rely entirely on references capable of refutation, or that the Examiner provide a formal affidavit, consistent with 37 CFR 1.104(d)(2) and MPEP § 2144.04. As the recent Federal Circuit decision in *In re Sang Su Lee*, 2002 U.S. App. LEXIS 855 (Fed. Cir. January 18, 2002) makes clear, Official Notice asserted outside the scope of cited references cannot reject Applicant’s claims in the face of persistent Applicant requests for the providing of references.

II. REJECTION ANALYSIS IS OVERLY GENERALIZED

Related to the Applicants' persistent objections to Official Notice assertions by the Examiner, is the overly generalized high-level analysis conducted by the Examiner with regards to the Applicants' claims. One example of such an analysis can be found on page 3 of the Office Action. "Therefore, it is the Examiner's opinion that the differences between the Applicants' invention and the Yamamoto et al. reference are **merely** found in the production of an invoice and the particulars of a warranty and its application [emphasis added]." A quick reading of Applicants' claim 16 makes clear that each and every method step in Claim 16 relates to an invoice or warranty function. **What the Examiner characterizes as "mere" constitutes the primary thrust of Claim 16.** Thus, the Examiner has admitted in the Office Action that the primary reference relied upon by the Examiner in rejecting Applicants' Claim 16 is different from the Applicants' invention with respect to "warranty and invoice processing" which is the primary thrust of Claim 16. Yet, that same Office Action cites U.S. Patent 6,141,629 to Yamamoto et al. ("Yamamoto") as the primary reference in rejecting Claim 16 despite the significant differences between Claim 16 and Yamamoto.

Other examples of such straw-man refutations can be identified in the prosecution history to date. However, consistent with the analysis above, Applicants' claims must be examined on an element-by-element basis. Applicants' claims cannot be generalized to the level of invoice and warranty processing, and then rejected on the basis of Official Notice.

III. THE SCOPE OF EXAMINER'S OFFICIAL NOTICE EXCEEDED THE SCOPE OF THE RYDER DISCLOSURE

To support a broad assertion of Official Notice in the Office Action, the Examiner cites the Ryder disclosure. However, the scope of Official Notice asserted by the Examiner far exceeds the scope of the Ryder Reference. For example, on Page 7 of the Office Action the "Examiner takes Official Notice that an entity who performs service on an asset for a second entity and generates a warranty report and/or maintenance invoice, and warranty handling is well

known to those of ordinary skill in the art.” A review of the Ryder disclosure will reveal that entity-awareness, warranty reports, maintenance invoices, and other aspects of Applicants’ claims are not disclosed in the Ryder reference. Thus, the Ryder disclosure cannot support the scope of Examiner’s Official Notice.

With respect to Claim 16, the mismatch in scope between the Official Notice and the Ryder disclosure is particularly striking. An initial review of the Ryder disclosure indicates that the Ryder disclosure is not an automatic system for “gathering and analyzing data without human intervention” as in Applicants’ Claim 16. All of the warranty and invoice functions in the Ryder disclosure require an “attendant.” The hand-held computer devices in Ryder require human intervention. No processing can occur in the Ryder disclosure until the **attendant** causes the touching of a “coin-shaped data-memory button on the vehicle with a probe from the computer.” Thus, in the Ryder disclosure it states that “the **attendant** automatically records the truck’s vehicle number [emphasis added]” instead of the stating that the system automatically records the truck’s vehicle number. Thus, the system described in the Ryder disclosure requires “human intervention.” The Ryder system “informs the technician if a repair is covered by warranty” but does not generate an invoice or a warranty report. Such tasks are left for the technician to perform. Moreover, the Ryder reference is silent on the question of the criteria used to determine whether a repair is covered by warranty. There is no mention of asset usage, a predetermined standard, a warranty period, or a warranty report. Just as Yamamoto fails to disclose any of the four steps in Claim 16, the Ryder reference similarly fails to disclose even one of the method steps in Claim 16. Thus, the Examiner’s rejection of Applicants’ claims using the Ryder Reference to support the Official Notice is traversed.

IV. CITED REFERENCES FAIL TO DISCLOSE ALL CLAIM ELEMENTS

A. Warranty and Invoice Processing

Contrary to the implicit assertions of the Office Action, the aggregation of all references cited by the Examiner fail to disclose all of the Applicants’ claim elements. As the Examiner

admitted in the Office Action, Yamamoto discloses no element related to invoices or warranties [Page 3, “it is the Examiner’s opinion that the **differences** between the Applicants’ invention and the Yamamoto et al. reference are **merely** found in the production of an invoice and the particulars of a warranty and its application”]. Similarly, the words “invoice” and “warranty” (and their equivalents) are notably absent from the lengthy 224 column disclosure in U.S. Patent 5,953,707 to Huang (“Huang”). The ability to create ad hoc reports in Huang does not support a finding of obviousness with respect to the automated process steps of Applicants’ Claim 16.

Examiner has yet to produce a reference that discloses even one of the claimed process steps in Applicant’s “method for automatically gathering and analyzing data without human intervention.” Huang requires human intervention to define the criteria and generate a report. The “generating of a maintenance invoice” is not disclosed in the cited references. Neither Huang nor Ryder generates invoices. The limitation “when service is performed on the asset” is not disclosed. The system in Huang is not cognizant of the concept of performing service on an asset. The “indication of the amount of usage of the asset” on the invoice is not disclosed. Yamamoto is concerned with individual components, not the entire asset as a whole. “[T]ransmitting the maintenance invoice to an administrative controller” is not included in any of the disclosures because the concept of an “invoice” is not included in any of the disclosures. The “comparing” of the “amount of usage” with a “predetermined standard” is not disclosed. The used of a “predetermined standard” to represent a “warranty period” is not disclosed. The generation of a “warranty report” is not disclosed. The production of such a report when “the amount of usage is less than the predetermined standard” is not disclosed. Neither Yamamoto, Huang, Barzilai, nor Ryder discloses these elements. The cited references cannot be said to perform comparisons on elements that are not even disclosed. The cited references cannot be said to disclose automated processing requiring no human intervention when the functionality is not even disclosed in a manual context.

B. An analysis controller located at a second location remote from said local controller

Claims 21-48 each include the claim element of “an analysis controller located at a *second location remote* from said local controller [emphasis added].” The disclosure in Ryder does not address hardware configurations at this level of detail, and thus Ryder cannot disclose this element. Instead, the Examiner relies on Yamamoto in asserting that this claim element is known in the art. However, such a reading of Yamamoto is inconsistent with the disclosure in Yamamoto.

The input terminal (element 21 in Fig. 12 of Yamamoto) cannot constitute an “analysis controller” of Applicants’ Claim 21. For Element 21 in Fig. 12 to constitute an “analysis controller,” the unmanned dump trucks at 10, 11, 12, and 13 of Fig. 12 would need to constitute “local controllers” because Applicants’ Claim 21 provides that “an analysis controller . . . is responsive to said acquired data from a plurality of local controllers for generating an analysis of said acquired data from said plurality of said local controllers.” The dump trucks at 10, 11 12, and 13 of Yamamoto Fig. 12 cannot constitute “local controllers” because each “local controller” is associated with a “receiver” that receives “acquired data” sent by a “transmitter” after being captured by a “data acquisition device.” **For the Examiner’s assertion to be correct, the unmanned dump trucks at 10, 11, 12, and 13 of Yamamoto Fig. 12 would need to include a data acquisition device, a transmitter for *intra*-truck communication, a receiver to receive an *intra*-truck communication, and a local controller located on the truck to forward the *intra*-truck communication to the analysis controller.** Yamamoto fails to disclose that each truck contains a transmitter, a receiver, and a local controller for transmitting acquired data relating to a truck and a receiver on that same truck. Thus, the computer at 21 in Fig. 12 of Yamamoto cannot be an “analysis controller located at a second location remote from said local controller.”

C. Examiner fails to cite a disclosure of “responsible parties” functionality

Yamamoto does not disclose any cognizance of entity-based awareness, and thus Yamamoto cannot be said to disclose processing based on “responsible parties.” Yamamoto is silent on concepts of ownership, suppliers, customers, users, manufacturers, and service providers. U.S. Patent 6,012,045 to Barzilai et al. (“Barzilai”) discloses a very limited form of entity-awareness, one that is limited to buyers and sellers at the time in which a buyer makes a bid to purchase an asset. After a purchase occurs with Barzilai, there is no subsequent processing, no follow-up of responsibilities, no dividing of roles between the buyer and the seller. In the Applicants’ claims, post-transaction asset usage determines which party is a “responsible party.” Barzilai cannot be said to disclose this functionality because Barzilai is silent on any type of post-sale processing. Barzilai ends before the Applicants’ invention begins.

D. Dependent claims

At least one of the claim elements discussed above is included in each of Applicants’ independent claims. All independent claims are in condition for allowance due to the analysis discussed above. Thus, all dependent claims are also in condition for allowance, based on the claim elements and arguments relating to the independent claims. However, the dependent claims also include additional claim elements not included in any independent claims. Thus, the dependent claims include claim elements that independently support the conclusion that the dependent claims are in condition for allowance. Such elements include “procurement and utilization” reports, the ability to “manage and control maintenance information,” the posting of a “management” report on a website maintained on the Internet, and other claim elements are more thoroughly discussed in Applicants’ Office Action Response dated September 5, 2001.

V. THE CITED REFERENCES TEACH AWAY FROM EACH OTHER

In order to support a finding of obviousness pursuant to Section 103(a), there must be an affirmative motivation or suggestion in the art to combine references. The Examiner has failed

to identify such a motivation or suggestion because in fact, the cited references teach away from each other. The Examiner ignores the particular perspectives and uses of the cited references. Thus, the Examiner ignores the obstacles to the asserted combinations that are intrinsic to the references themselves.

Yamamoto ignores all non-technical information. There is no awareness of warranties, invoices, contracts, business-based utilization data, contracting entities, manufacturers, etc. Moreover, Yamamoto does not attempt in any way to aggregate data to generate an analysis. Rather, Yamamoto is focused solely on the benefit of keeping machines running on an individualized basis. Yamamoto may permit “world-wide” processing as asserted by the Examiner, but that simply means that Yamamoto may perform processing on an individual machine by individual machine basis, on machines located anywhere in the world. Thus, in contrast to Examiner’s assertions, Yamamoto does not teach a “global management system.” No matter the geographic scope of machines “managed” by a Yamamoto system, such a system is not equipped for any analysis reaching outside of the scope of a single individual machine. This limited perspective renders irrelevant Examiner’s general comment that “construction projects are highly coordinated, highly time dependent activities” because Yamamoto discloses no awareness of any coordination or time dependency between activities. Moreover, Yamamoto is totally unconcerned with the relationships between various entities, and the contracts that may define such relationships. Yamamoto can only answer the question of when the next maintenance work for a particular machine is to take place.

In contrast, Barzilai discloses an electronic bid and auction system exclusively concerned solely with activities leading up to sale. Barzilai has no post-sale awareness to support the processing as claimed by the Applicants, or as disclosed by Yamamoto. Barzilai treats each asset as a black box, in contrast to both the Applicants’ invention and Yamamoto. The data used by Barzilai is totally different than the type of data used by Yamamoto.

Huang discloses an inventory management system that teaches away from both Yamamoto and Barzilai. Each asset in Huang is a mere “black box” in contrast to Yamamoto

which is exclusively concerned with the inner workings of a machine. In contrast to Barzilai, Huang incorporates no aspects on intra-entity awareness, where Barzilai is exclusively concerned with generating a sale.

There is no affirmative suggestion in the art to combine these references. There is no overlap in the processing performed by the three systems. The fact that a combination of features can be useful is not to say that patent law treats such a combination as obvious.

CONCLUSION

Claims 16 and 21-48 are in condition for allowance. The Applicants' request a face-to-face personal interview with the Examiner and Supervisory Examiner. At that interview, the Applicants expect to be represented by their attorney and a client representative. The Applicants would appreciate the courtesy of a telephone call to schedule an interview at the convenience of the Examiner and Supervisory Examiner.

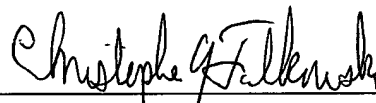
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Respectfully submitted,

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